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EXAMINER

SHRADER, LAWRENCE J

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,331

Applicant(s)

NAGALKAR, DHANANJAY A.

Examiner

Lawrence Shrader

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed by the Applicant on 27 May 2004 and the petition to revive granted on 2 June 2004.

2. The Applicant's arguments in the amendment have been fully considered, but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a "useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

Claim 1 recites a system comprising a central site and a development site, and claim 19 recites a central site. Neither claim has any reference to a computer. These claims do not

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necessarily require or strongly suggest indisputable evidence that some hardware or tangible embodiment is being used because the system comprising sites that manage products can be understood to be simply software without any reference to any tangible embodiment. The claims, as recited, amount to an abstract idea failing to suggest an application with a tangible embodiment leading to a concrete and tangible result. Thus, the claim fails to fulfill the requirements of the practical application test and is rejected for leading to a non-statutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Mandeberg et al., U.S. Patent 6,038,545 (hereinafter referred to as Mandeberg).

In regard to claim 1:

Mandeberg discloses a system for managing content.

"a central site for supporting a generic product with a plurality of features; and

at least one development site connecting to the central site, each of the at least one development site generating a customized product of the generic product based on the plurality of features, testing said customized product, and maintaining said customized product at said central site."

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Mandeberg discloses a central site for supporting a generic product having a plurality of features, which may be customized and tests by on-site users (development sites) based on a plurality of features (e.g., Figures 1 and 6; column 5, line 45 to column 6, line 16; column 6, lines 56 – 59; testing at column 9, lines 33 – 37). The product maintained at the central site is disclosed at column 5, lines 45 – 59) where test reports are also sent.

In regard to claim 2, incorporating the rejection of claim 1:

*"a runtime engine for performing the plurality of features of the generic product; and
a visual customization tool for interfacing with the at least one development site to create the customized product of the generic product based on the plurality of features, the customized product created using the visual customization tool interacting with the runtime engine."*

Mandeberg discloses a control and monitoring station and a customization tool to (CreativePartner agent) to interface with the development site (e.g., Figures 1, 2, and 3; column 10, lines 21 – 52).

In regard to claim 3, incorporating the rejection of claim 2:

"...wherein each of the plurality of features corresponds to a defined interface which can be invoked from the visual customization tool."

See Figure 3 and column 10, lines 35 – 52.

In regard to claim 4, incorporating the rejection of claim 2:

"...wherein the custom product comprises:

a parameter module generator for activating a portion of the plurality of features with custom values via the defined interface of each feature in the portion of the plurality of features; and"

See Mandeberg column 10, lines 21 – 34.

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"a visual diagram generator for configuring the portion of the plurality of features that are activated by the parameter module generator to generate a state machine configuration."

The control and monitoring station (Figures 1 and 3) configures the plurality of features to be activated for on-site use.

In regard to claim 5, incorporating the rejection of claim 2:

"...further comprising a testing toolkit which includes:

a test driver tool for triggering the runtime engine to perform a test on the customized product; and"

See Mandenberg column 10, lines 30 – 34.

"a visual log viewer for visually viewing debug data generated by the runtime engine during the test on the customized product."

See Mandenberg column 11, line 51 to column 12, line 2.

In regard to claim 6:

Rejected for the same corresponding reasons put forth in the rejection of the corresponding system of claim 1.

In regard to claim 11, incorporating the rejection of claim 6:

"... wherein the building comprises:

selecting a portion of the plurality of features of the generic product;

specifying custom values for the portion of the plurality of features;"

See Mandenberg column 3, lines 10 – 21 where a portion of generic features may be configured and custom values for a specific site may be configured (column 4, lines 1 – 7).

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"generating a parameter module based on the portion of the plurality of features and the custom values for the portion of the plurality of features, the parameter module activating the portion of the plurality of features with the custom values; and"

See Mandenberg column 10, lines 21 – 34.

"constructing a visual diagram using the portion of features, the visual diagram configuring the portion of the plurality of features to form a state machine."

The control and monitoring station (Figures 1 and 3) configures the plurality of features to be activated for on-site use.

In regard to claim 12, incorporating the rejection of claim 11:

"...wherein the selecting is performed via a parameter module generator in a visual customization tool; and

the specifying is performed through defined interfaces of the portion of the plurality of features via the parameter module generator; and

the constructing is performed via a visual diagram generator in the visual customization tool."

Mandenberg discloses a control and monitoring station to construct customized product, working with the CreativePartner Agent acting as an interface with the distributed sites through which specifying the plurality of features is performed (e.g., Figure 3).

In regard to claim 13, incorporating the rejection of claim 11:

"...wherein the testing comprises:

triggering, by the development site through a test driver tool, a runtime engine at the central site to test the customized product; and

See Mandenberg column 6, lines 4 – 16.

executing, by the runtime engine, the customized product based on the parameter module and the visual diagram."

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The control and monitoring station (Figures 1 and 3) configures the plurality of features to be activated for on-site use.

In regard to claim 14, incorporating the rejection of claim 13:

"...further comprising

generating, by the runtime engine, debug data based on the executing the customized product;

displaying the debug data on a visual log viewer; and

debugging, by the development site, the customized product based on the debug data displayed on the visual log viewer."

Errors are detected and debugged at the development site and the monitoring station at the central site receives reports error reports (column 11, line 16 to column 12, line 32).

In regard to claim 15:

A computer-readable medium rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 6.

In regard to claim 16, incorporating the rejection of claim 15:

A computer-readable medium rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 11.

In regard to claim 17, incorporating the rejection of claim 16:

A computer-readable medium rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 13.

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In regard to claim 18, incorporating the rejection of claim 17:

A computer-readable medium rejected for the same corresponding reasons put forth in the rejection of the corresponding method of claim 14.

In regard to claim 19:

"A central site supporting a generic product with a plurality of features to receive a request to test a customized product, wherein the customized product is generated by at least one development site based on the generic product and the plurality of features and is maintained at the central site."

Mandeberg discloses a central site for supporting a generic product having a plurality of features, which may be customized and tests by on-site users (development sites) based on a plurality of features (e.g., Figures 1 and 6; column 5, line 45 to column 6, line 16; column 6, lines 56 – 59; testing at column 9, lines 33 – 37). The product maintained at the central site is disclosed at column 5, lines 45 – 59) where test reports are also sent.

In regard to claim 20, incorporating the rejection of claim 19:

"...wherein the central site includes:

a runtime engine to test the customized product; and

a visual customization tool to communicate with the at least one development site to create the customized product by interacting with the runtime engine."

See Figure 3.

In regard to claim 21, incorporating the rejection of claim 19:

"...further including a testing toolkit comprising:

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a test driver tool for triggering the runtime engine to perform a test on the customized product; and

a visual log viewer for visually viewing debug data generated by the runtime engine during the test on the customized product."

See Mandeberg column 10, lines 30 – 34; and column 11, line 51 to column 12, line 2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being patentable over Mandeberg et al., U.S. Patent 6,038,545, as applied to claim 6 above, in view of Alexander et al., U.S. Patent 5,986,654 (hereinafter referred to as Alexander).

In regard to claims 7 and 9, incorporating the rejection of claim 6:

"...the generic product includes a web site."

"...the customized product includes a customized web site."

Mandeberg teaches a system for managing content, but does not teach that the managed content is a web page as either a generic product or a customized product. However, Alexander does disclose a means to customize a generic web page (column 16, lines 7 – 21). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine

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the content management and testing system of Mukherjee to properly configure the information received from the central site, with the Alexander invention supplying a generic web page as a product to be customized. Because of the ubiquitous nature of the Internet, it would be reasonable to provide web pages as a managed product available in the Mandeborg system because a point of sale system implementing a website would be beneficial to measure effectiveness of promotions as taught by Mandeborg at column 4, lines 8 – 19).

9. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being patentable over Mandeborg et al., U.S. Patent 6,038,545, as applied to claim 6 above, in view of Elrod et al., U.S. Patent 5,455,852 (hereinafter referred to as Elrod).

In regard to claims 8 and 10, incorporating the rejection of claim 6:

"...the generic product includes a protocol."

"...the customized product includes a variant of a protocol."

Mandeborg teaches a system for managing content, but does not explicitly teach that the managed content includes a protocol as either a generic product or a customized product. However, Elrod does disclose a means to customize a protocol (column 6, line 60 to column 7, line 9). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the content management system of Mandeborg to properly configure the information received from the generic central site, with the Elrod invention supplying a generic protocol as a product, because the needs of a particular development site may be satisfied by having the ability to customize a particular protocol for a specific processes or a unique standards requirement.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Shrader whose telephone number is (571) 272-3734. The examiner can normally be reached on M-F 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lawrence Shrader
Examiner
Art Unit 2124

17 February 2005


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